

Application No.: 09/665,366

Docket No.: EN9-99-026

REMARKS**Status of Claims:**

Claims 1-80 are pending in the application. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Disclosure Supporting the Instant Amendment:

Claims 79-80 are hereby amended to recite: "at least a portion of which are fusible." Support for this recitation was present in the original disclosure at, for example, page 27, lines 8-11.

Rejections Under 35 U.S.C. § 112, 1st Paragraph:

Claims 79-80 were rejected under 35 U.S.C. § 112, 1st Paragraph, as failing to comply with enablement.

Claims 79-80 are hereby amended to recite "at least a portion of which are fusible."

Rejections Under 35 U.S.C. § 103(a):

Claims 1-3, 7-10, 12-14, 16-18, 20-21, 37-42, 45-48, 51-53, 64-68, and 79-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takenouchi (5,744,758) in view of McCormack (6,054,761).

Claims 4-6, 11, 15, 19, 24-33, 35-36, 49-50, and 60-63 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Takenouchi/McCormack in view of Lake (4,915,983).

Claims 22-23 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Takenouchi/McCormack in view of Arndt (3,601,523).

Application No.: 09/665,366

Docket No.: EN9-99-026

Claims 34 and 59 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Takenouchi/McCormack in view of Dishon (4,921,157).

Claims 37-44 and 69-78 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Takenouchi/McCormack in view of Pepe (5,635,010).

The present invention relates to metallurgical bonding. Takenouchi relates to conductive paste bonding. The Examiner acknowledges that Takenouchi fails to teach metallurgical bonding. The Examiner cites McCormack for metallurgical bonding using conductive pastes. Where McCormack is disqualified, each of the above rejections under §103 is overcome. McCormack has a §102(e) date of December 1, 1998. The present application is based on IBM Disclosure END8-1998-0164, dated 09-09-98.

Attached hereto is an affidavit executed by the inventor which states that prior to the McCormack filing the inventor "had conceived the present invention and had prepared drawings and or other descriptions of the invention that were sufficiently specific to enable a person of skill in the art to practice the invention."¹

Declaration Under 37 CFR 1.131:

The claims of the present invention were rejected under § 103 over various combinations of art, each of which included McCormack. Attached hereto is an affidavit of the inventor stating that, prior to the filing of McCormack, that the inventor "had conceived the present invention and had prepared drawings and or other descriptions of the invention that were sufficiently specific to enable a person of skill in the art to practice the invention." The Supreme Court has held that although "reduction to practice is sufficient evidence of completion, it does not follow that proof of reduction to practice is necessary in every case...one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice."² The *Pfaff* Court promulgated two tests of invention including "proof that prior to the critical date

¹ See *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 48 U.S.P.Q. 2d 1641 (1998) ("That condition [that the invention is ready for patenting] may be satisfied in at least two ways:...or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.").

Application No.: 09/665,366

Docket No.: EN9-99-026

the inventor had prepared drawings or other descriptions that were sufficiently specific to enable a person skilled in the art to practice the invention."³

In view of the present affidavit, the Applicant respectfully requests that McCormack be disqualified as a reference and that the rejections under § 103, based on combinations of art including McCormack, be withdrawn.

Conclusion.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185.

Dated: *September 10, 2004*

Respectfully submitted,

By 

John A. Evans

Registration No.: 44,100

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036-3425

(202) 331-7111

(202) 293-6229 (Fax)

Attorney for Applicant

² *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 66 (1998).

³ *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67 (1998).